



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| | | | |
|-----------------|-------------|----------------------|---------------------|
| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|

09/600,134 09/11/00 LANG

G 05725.0654

EXAMINER

IM22/0911

FINNEGAN HENDERSON FARABOW
GARRETT & DUNNER
1300 I STREET NW
WASHINGTON DC 20005

PUBL. A

ART UNIT

PAPER NUMBER

1751

DATE MAILED:

09/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/600,134

Applicant(s)

LANG ET AL.

Examiner

ANIL K PURI

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 22-58 are pending in this application.

Response to Amendment

The office action is in response to application amendment under 37 C.F.R. 111 filed on 8/13/01 as paper No.9. The rejection of 22-58 under the judicially created doctrine of obviousness type double patenting as being unpatenable over claims 29-61 of co-pending U.S. application No. 09/600136 is **maintained** for the reason of record. The basis of the rejection is same as given in the previous office action in paper No.7 dated 04/11/01. Secondly applicant has not filed terminal disclaimer in compliance with 37 CFR 1.321C which may be used to overcome an actual or provisional rejection based on nonstatutory double patenting ground the conflicting application is shown to be commonly owned with this application. See 37 1.130(b)

Rejection of claims 22-24 and 27-31 are rejected under 35 U.S.C § 103(a) as being unpatenable over Aaslyng et al [WO 97/19998] is **maintained** for the reason of record. The basis of the rejection is same as given in the previous office action in paper No 7 dated 4/11/01

Rejection of claims 22,25-26, 32-58 under 35 U.S.C § 103(a) as being unpatentable over Aaslyng et al [WO 97/19998] in view of Audousset et al [U.S. 5578087] is **maintained** for the reason of record. The basis of the rejection is the same as given in the previous office action in paper No.7 dated 4/11/01

Response to Arguments

Rejection of claims 22-24 and 27-31 are under 35 U.S.C § as being unpatenable over Aaslyng '998

Applicant's arguments filed 8/13/01 have been fully considered but they are not persuasive. Applicant urges that office's argument fail to establish a prima facie case of obviousness. Hence, the rejection should be withdrawn with respect to all of the claims 22-58.

The examiner position is that the applicants arguments are not found persuasive because prior art of Aaslyng teaches dyeing composition comprising laccase enzyme, (see page 3 lines 20-25), dye precursor including p-aminophenol, o-aminophenol, p-phenylenediamine (see page 6 lines 27-37 and page 7 lines 1-23) and modifier (see page 8 lines 1-4) Further dye precursor p-aminophenol and derivatives 3- methyl-4 aminophenol which has similar application of dyeing hair when combine with one or two modifier or couplers(see page 10 line 2) to formulate a composition for dyeing hair.

Thus a person of ordinary skill in the art would be motivated ^{to use} the prior art of Aaslyng to substitute p-aminophenol with 3-methyl-4 amino phenol because they thought to be functionally equivalent by Aaslyng. Such modification would be obvious because one would expect that use of 3-methyl-4 amino phenol is similarly useful and applicable in hair dying composition.

2) Rejection of claims 22,25-26,32-58 under 35 U.S.C § 103(a) as being unpatenable over Aaslyng'998 in view of Audousset '903

Art Unit: 1751

Applicant arguments filed 8/13/01 have been fully considered but they are not persuasive. Applicant urges that office argument fail to establish a *prima facie* case of obviousness, because Audousset provides no motivation for using the at least one oxidation base recited in claim 22 and Aaslyng provides no motivation to use at least one enzyme of laccase type recited in claim 22. Other than hindsight, there is no reason to combine the two references.

The examiner position is that the arguments are not found persuasive because prior art of Aaslyng teaches hair dyeing composition comprising laccase enzyme, oxidation dye precursor including p-aminophenol and modifier including m-phenylenediamine, While secondary reference of Audousset teaches dyeing composition of keratin fiber a specific 4-amino-3-methylphenol as oxidation base (see col.6 lines 25-27) along with other conventionally used ingredients as discussed in previous office action on paper No. 7 dated 4/11/01.

Absent a showing of new or unobvious results. It would have been obvious to substitute 4-amino-3-methylphenol with laccase, modifiers and other conventional ingredients in dyeing composition because each component of the dye composition is known individually to dye keratin fiber and the person of ordinary skill in the art would expect such composition to improve dyeing keratinous fiber in an additive or cumulative manner.

It is *prima facie obvious* to combine two compositions each taught by the Aaslyng and Audousset to be useful for the hair dyeing, in order to form a third

composition which is to be used for the very same keratin hair dyeing purpose. See In re Kerkhoven, 205 USPQ 1069,1072

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANIL K PURI whose telephone number is 703/605-4427. The examiner can normally be reached on 8:30 AM TO 5:30 PM.

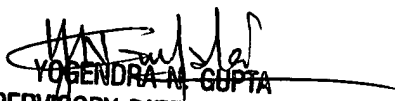
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Dr.Yogendra Gupta** can be reached on (703)-308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703/305-3599 for regular communications and 703/305-3599 for After Final communications.

Application/Control Number: 09/600,134

Page 6

Art Unit: 1751

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/308-0661.


YOGENDRA M. GUPTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

AKP
September 7, 2001